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on January 18, 2004

Name of Rep. HENRY I. SCHANZER

Signature Henry I. Schanzer

date 1/18/04

s/n 09/763,247 ✓

OPT 33-27

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carroll et al.
Serial Number : 09/763,247
For : WAVE ENERGY CONVERTERS UTILIZING
PRESSURE DIFFERENCES
Filed : 10/15/01
Examiner : GONZALEZ, J.C.
Art Unit : 2834

PETITION TO WITHDRAW RECORDED TERMINAL DISCLAIMER
AND TO DELAY ISSUE OF THE PATENT

Hon. Commissioner of Patents and Trademarks
Alexandria, VA 22313-1450

Sir:

A terminal disclaimer has been filed in the above-identified application. Withdrawal of the terminal disclaimer is requested. Delay of the issue of the patent pending a decision on this petition is also requested.

A check in the amount of \$130.00 (37 CFR 1.17(h)) for the Petition filing fee is enclosed herewith.

FACTS

In an Office Action dated August 14, 2003, the Examiner rejected Claims 1-3 and Claim 18 as being unpatentable, under the Doctrine of Double Patenting, over Claims 1-8 of USP #6,291,904. Both the patent and the present application have a common assignee. To overcome this rejection, a terminal disclaimer was filed on November 11, 2003 limiting the life of any patent granted on the present application to that of the life of the aforementioned patent #6,291,904.

Subsequent to the filing of the terminal disclaimer, and for the purpose of withdrawing it, all the claims subject to a double patenting rejection were cancelled.

The application has now been allowed and the issue fee is due by February 23, 2004. The issue fee has not been paid.

The pending and allowed claims are Claims 10-17. At no time were these claims rejected for double patenting.

POINT TO BE REVIEWED

MPEP §1490 (page 1400-86, August 2001 ed.) discusses withdrawal of a previously filed terminal disclaimer. It appears to the applicant that the only point to be reviewed is whether withdrawal of the terminal disclaimer would affect the patentability of Claims 10-17. It is noted that prosecution of the application is closed and amendments to the claims are no longer permitted. In any event, applicant warrants that no attempt will be made to amend the application claims.

At the time the double patenting rejection was made by the Examiner, in an Office Action dated 8/14/03, Claims 10-17 were pending. These claims were excluded from the double patenting rejection. No amendments to these claims were subsequently made.

Claims 10-17 are, in fact, not subject to a double patenting rejection because the subject matter of the claims of the application and the patent are mutually exclusive. Thus, all of Claims 10-17 of the application specify a movable cylinder while

all the claims of the patent specify a stationary cylinder.

Accordingly, and consistent with the position taken by the Examiner, the application claims do not provide an "unjustified or improper timewise extension of the 'right to exclude' granted" by the patent.

Withdrawal of the previously filed terminal disclaimer, as not being required for the allowability of any of the claims of the application is requested.

Also while payment of the issue fee will be paid by the due date (Feb. 23, 2004), delay of the issue of the granted patent, pending a decision of this petition, is also requested.

Respectfully submitted,



Michael Y. Epstein

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